Remarks

Applicant has amended claims 3 and 8. No new matter is added by this Amendment. Entry of the Amendment, and favorable consideration thereof is earnestly requested.

The Examiner has rejected claims 1-6 and 8-10 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,987,464 to Schneider ("the '464 patent"). The Examiner has also rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over the '464 patent in view of U.S. Patent No. 6,006,332 to Rabne et al. ("the '332 patent"). These rejections are respectfully traversed.

102(e) Rejection:

Claims 1-10 require among other limitations, an Internet server, software executing on said Internet server for <u>receiving a transfer request</u>, and software executing on said Internet server for querying a database of information records to retrieve an information record corresponding to a transfer request, for querying a <u>database of recordation forms</u> to retrieve a recordation form corresponding to said transfer request, and for <u>combining the retrieved information record with the retrieved recordation form to generate a document</u>.

Specific legal forms are necessary to transfer intellectual property. The system of the current invention provides database 36 for storing such recordation forms. The system also provides an Internet server 20, a database 34 containing information necessary to complete an intellectual property transfer, and software that operates on the server 20 for receiving a <u>transfer request 16</u> from a client who needs to transfer intellectual property. The transfer request includes information necessary to identify the intellectual property and complete the transfer, such as an intellectual property number, country, date of transfer, and new owner. Upon receipt of the transfer request 16, soft-

ware operating on the server 20 queries database 34 for intellectual property records and database 36 for recordation forms necessary to complete the requested transfer. The information obtained from the databases 34 and 36 is <u>combined to generate a document 22</u> that allows the client to transfer the property described in the transfer request 16. The combined documents are then transmitted to the client.

The Examiner has submitted that the '464 patent discloses software operating on the server for <u>receiving a transfer request</u> indicative of a transfer of rights to property as required by Claim 1. Applicant respectfully disagrees. A program 34 of the '454 patent cited by the Examiner is described as an "information providing program 34" and an "update program 34 for applying modifications or updates to the reference data files 30" (col. 7, lines 26-30; col. 11, lines 6-9). The program 34 is further described "as executing to receive a current delivery 122 of data containing both newly issued patent data 354 and control data 126" (col. 16, 37-39). Despite the multiple functions of the program 34, nowhere is it disclosed or even suggested that said program 34 includes software operating on the server <u>for receiving a transfer request</u> indicative of a transfer of rights to property.

The Examiner has further submitted that the '464 patent discloses at least one database containing a plurality of recordation forms accessible by an internet server. Applicant respectfully disagrees. The '464 patent discloses a "master database of all premature expired patents 140" and a "master database of all patents 350," however neither of these correspond to a <u>database containing a plurality of recordation forms</u> (fig. 12a; col. 16, lines 34-46). The database 140 and database 350 contain updated records of expired patents and all patents, respectively, and not recordation forms necessary for transfer of intellectual property. Therefore, Applicant respectfully submits that nowhere, does the '464 patent disclose "at least one database <u>containing a plurality of recordation forms</u> accessible by said Internet server" as required by all pending claims.

Moreover, there is no teaching or suggestion in the '464 patent to modify either of the databases 140 or 350 to contain recordation forms. It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that in this case there is no suggestion in the prior art to modify the '464 patent according to the present claims. The '464 patent is directed toward a system and method for updating patent files "so that the patent files will include newly issued patents and premature expired ones" while the present application is directed toward a system for automating the transfer of intellectual property rights (col. 4, lines 54-57). The recordation forms of the present claims are not newly issued or premature expired patents, and do not require frequent updates. Accordingly, it would not be obvious to modify the '464 invention to include a database containing recordation forms because this would obviate the purpose of the '464 invention.

The '464 patent also fails to disclose combining a retrieved information record with a retrieved recordation form to generate a document as required by Claims 1 and 2, or to generate a transfer document as required by Claims 3-10. The Examiner has submitted that such disclosure is found in column 16, lines 14-63 of the '464 patent. However, the cited text describes steps to update a master database of all patents 350, a master database of premature expired patents 140, and create a new file 352 of potentially reusable data 30, where the new file 352 is created by copying newly issued patent data 354 to a new data file 352 (col. 16, (col. 16, lines 34-35, 46-48). Nowhere in this passage, or anywhere else, does the '464 patent describe <u>combining</u> a <u>retrieved information</u> record corresponding to a transfer request with a <u>retrieved recordation form</u> corresponding to said transfer request to <u>generate a document</u> or a <u>transfer document</u> as required by the pending claims.

103(a) Rejection:

As described above, Applicant submits that the '464 patent fails to disclose, teach or suggest a database containing a plurality of recordation forms or software for combining a retrieved information record with a retrieved recordation form to generate a transfer document as required by claim 7. The Examiner correctly points out that the '464 patent additionally fails to disclose software for transmitting an executed transfer document to a property recordation authority as required by claim 7. The '332 patent fails to provide the missing disclosure of the '464 patent, thus no combination thereof can render any claim of the present application obvious.

For the foregoing reasons, it is respectfully submitted that claims 1 – 10, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respect-fully requested.

Respectfully submitted,

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